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| JERRY RICHARD POTTS 3248 VIA RIBERA ESCONDIDO, CA 92029 | | | EXAMINER | |
| | | | HOEY, ALISSA L | |
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 26

Application Number: 09/910,641
Filing Date: July 20, 2001
Appellant(s): HOLDEN, PERRIANN M.

Jerry R. Potts
For Appellant

EXAMINER'S ANSWER

MAILED
FEB 23 2004
GROUP 3700

This is in response to the appeal brief filed 12/13/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 31-23, 29 and 32 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

| | | |
|-----------|---------|---------|
| 3,985,383 | Yonkers | 10-1976 |
| 6,613,382 | Lee | 09-2003 |

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 21-23, 29 and 32 rejected under 35 U.S.C. 102 as being anticipated by Yonkers (US 3,985,383) and claim 27 is rejected under 35 U.S.C. 103 as being unpatentable over Yonkers in view of Lee (US 6,613,382). This rejection is set forth in prior Office Action, Paper No. 19.

(11) Response to Argument

Applicant commences his arguments with a long felt need argument. Examiner notes that long felt need arguments can't overcome a rejection under 35 U.S.C. 102. Applicant argues that Yonkers teaches away from Applicant's invention since it "does not suggest fun, which is the spirit of Appellant's invention". Patentability is not based on a fun but the structure and utility of the device. Further, Applicant argues that Yonkers discloses a device with a clunky structure. The device of Yonkers clearly reads on the structure as claimed by the Applicant. If the Yonkers device would be like "walking on a small stone or pebble" then Applicants device as claimed would be like "walking on a small stone or pebble".

In reference to argument that Yonkers does not anticipate claim 21, Applicant states that Yonkers does not teach a novelty fashion wear item. Examiner disagrees since any item worn/displayed on the body can be considered a novelty fashion wear item including the device of Yonkers that adheres to the skin of the user's body. Additionally, Applicant argues that Yonkers does not teach "a flexible pad having...a lower surface with a non-slip texture...". Yonkers teaches as claimed by Applicant "a lower surface with a non-slip texture.." (figure 4, identifier 18: column 3, lines 21-29). The lower surface (18) not only has a non-slip texture buy lower surface is a non-slip texture. Finally, Applicant argues that Yonkers fails to teach "said pad having it's lower surface provided with indicia to decorate said contoured surface area". Examiner disagrees, since Yonkers teaches indicia chosen from colors and shapes to decorate the contoured area (figure 6, identifiers 22, 24, 26 and 28: column 4, lines 10-19).

In reference to Applicant's arguments that claim 22 is not anticipated by Yonkers, Applicant argues that Yonkers does not teach "providing decorative fashion wear". Examiner disagrees, since as discussed earlier "decorative fashion wear" can be any item worn or attached to the body of a user. Yonkers provides a device to be attached to the body of a user. Secondly, Applicant argues that Yonkers fails to teach "said fashion wear including a flexible pad with a non-slip texture..". Examiner disagrees since the non-slip pad of Yonkers (18) is formed of a elastomeric material such as foam and sponge rubber containing glycerine or a smooth rubber stock which are flexible materials and are both also non-slip (column 3, lines 21-29). Applicants arguments directed to Yonkers failing to provide indicia on the contoured surface was addressed previously in this examiner answer.

In reference to arguments that Yonkers does not anticipate claim 23, Applicant states that Yonkers does not teach "a non-slip pad having a non-skin irritating adhesive material completely covering one of it's surfaces and decorative indicia covering at least a portion of another one of it's surfaces...". Examiner disagrees since Yonkers provides a pad (18) having a non-skin irritating material on one surface (figure 4, identifiers 14, 15, 16 and 18: column 3, lines 1-21). Manufacturers of skin adhesives inherently would make them non-irritating to a user's skin so that the user can put the adhesive on their skin and wear without irritation. The decorative indicia provided on the surface was addressed previously in this examiner's answer.

In response to Applicant's arguments that Yonkers does not anticipate claim 29. Applicant states that Yonkers fails to teach a "single piece construction". Applicant does

not ever claim a single piece construction and therefore the single piece construction will not be addressed any further by the Examiner. Further, examiner argues that Yonkers would not be suitable for use on other body parts including the feet, toes, knees or elbows of a user. Examiner disagrees, since nothing prevents the Yonkers device to be worn at any location on a user's body. The toes would be an ideal location for the device of Yonkers so a user can index through a stack of paper if the user lost the use of or lost their hands/arms.

Applicant argues that Yonkers fails to teach messages and advertisements as the indicia. Examiner notes that along with messages and advertisements is color and patterns as indicia Yonkers provides color and patterns as the selected indicia (figure 6, identifiers 22, 24, 26 and 28: column 4, lines 10-19). Further, Applicant argues that it would not have been obvious to have provided screen printing of Lee on the pad of Yonkers. Examiner disagrees since Lee (US 6,613,382) provides the use of screen printing as indicia and Yonkers provides a pad with indicia. Examiner is combining the pad and non-slip surface of Yonkers with the screen printing indicia means as taught in Lee. Yonkers provides a pad with color and pattern indicia and Lee provides screen printing indicia. Indicia of color, pattern and screen printing are all forms of indicia and interchanging one for the other provides a device with indicia for decoration. Applicant argues that Lee does not provide a non-slip surface. Examiner notes that she never states in the record that Lee does provide a non-slip surface. Finally, Applicant presents arguments that Lee should never have been used as a prior art reference due to the filing date of provisional application 60/220,357 filed July 24, 2000. Examiner brings

attention to both the Applicant and the Board that the screen printing indicia on the pad of claim 27 is not supported in the provisional application and therefore Lee is a proper reference based on the filing date of the application.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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February 20, 2004

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